

## REMARKS

Reconsideration is respectfully requested in view of any changes to the claims and the remarks herein. Please contact the undersigned to conduct a telephone interview in accordance with MPEP 713.01 to resolve any remaining requirements and/or issues prior to sending another Office Action. Relevant portions of MPEP 713.01 are included on the signature page of this amendment.

37 C.F.R. § 41.33 states:

### **§ 41.33 Amendments and affidavits or other evidence after appeal.**

(a) Amendments filed after the date of filing an appeal pursuant to § **41.31**(a)(1) through (a)(3) and prior to the date a brief is filed pursuant to § **41.37** may be admitted as provided in § **1.116** of this title.

The Appeal Brief was filed 12-01-2006.

37 C.F.R. § **1.116** states:

### **§ 1.116 Amendments and affidavits or other evidence after final action and prior to appeal.**

(e) An affidavit or other evidence submitted after a final rejection or other final action (§ **1.113**) in an application ... but before or on the same date of filing an appeal (§ **41.31** or § **41.61** of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

Applicants respectfully request that this Eighteenth Supplementary Response be entered. The following is “a showing of good and sufficient reasons why [this] ... evidence is necessary and was not earlier presented.”

The Examiner cites the article of Schuller which refers to the discovery of superconductivity in  $\text{MgB}_2$ . The Schuller article was first cited by the Examiner in the Final Action.

Applicants bring to the Examiner's attention that  $\text{MgB}_2$  was made at least as early as 1954, more than 30 years prior to Applicants' discovery of High  $T_c$  superconductivity, as reported in the following article:

**The Preparation and Structure of Magnesium Boride,  $\text{MgB}_2$**

Morton E. Jones and Richard E. Marsh

J. Am. Chem. Soc.; **1954**; 76(5) pp 1434 - 1436; DOI:

**10.1021/ja01634a089**

A copy of this article is attached herewith designated as Brief Attachment BM. This evidence was not earlier presented since the Schuller article was first cited by the Examiner in the Final Action. This evidence is necessary since it demonstrates that persons of ordinary skill in the art knew how to make  $\text{MgB}_2$  long before Applicants' discovery and is information that is know of should be known to the Examiner of the present application. An Examiner of a patent application handles a narrower field of technical subject matter than a panel of the Board of Appeals that reviews an applicant's appeal. Applicants submitted this Eighteenth Supplementary Response to provide the panel of the Board of Appeals reviewing this appeal basic knowledge known to persons of ordinary skill in the art and which is know or should be know to the Examiner. Applicants believe that this basic information is necessary since it will assist the Board in rendering a fair and equitable decision. This information was not earlier presented since the Examiner first cited the Schuller article in the Final Action and since the undersigned attorney was not aware of this article until 11/04/2008. Information well known to persons of skill in the art does not have to be provided in a patent application nor during prosecution unless it is requested by the Examiner or is necessary to respond to an issue that

arises during prosecution. The material MgB<sub>2</sub> arose during prosecution for the first time in the Final Action.

Please charge any fee necessary to enter this paper and any previous paper to deposit account 09-0468.

Respectfully submitted,

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